No. 02-1053

FILED
FEB 12 2007

IN THE

Supreme Court of the United States

THE READ CORPORATION, F.T. READ & SONS, INC., AND NORDBERG-READ, INC.,

Petitioners,

v.

POWERSCREEN OF AMERICA, INC., POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD. AND POWERSCREEN INTERNATIONAL, PLC,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ROBERT S. FRANK, JR.
ERIC J. MARANDETT
CHOATE, HALL & STEWART
53 State Street
Boston, MA 02109
(617)248-5000

RICHARD G. TARANTO *
FARR & TARANTO
1220 19th Street, N.W.
Suite 800
Washington, D.C. 20036
(202) 775-0184

* Counsel of Record

WILSON-EPES PRINTING CO., INC – (202) 789-0096 – WASHINGTON, D.C. 20001

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
BRIEF IN OPPOSITION	1
STATEMENT	2
ARGUMENT	8
A. Certiorari Should Not Be Granted With Respect to The Sufficiency Of The Evidence Question	8
B. Certiorari Should Not Be Granted With Respect To The Preservation Of Issues Question	14
CONCLUSION	16

TABLE OF AUTHORITIES

CASES — Page

Augustine Medical, Inc. v. Gaymar Industries, Inc., 181 F.3d 1291 (Fed. Cir. 1999) 13

Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303 (Fed. Cir. 1998) 13

Correa v. Hospital San Francisco, 69 F.3d 1184 (1st Cir. 1995) 15

Festo Corp. v. Shoketsu Kinzoko Kogyo Kabushiki Co., 535 U.S. 722 (2002) 13

Galloway v. United States, 319 U.S. 372 (1943) ... 12

Hoechst Celanese Corp. v. BP Chemicals Ltd., 78 F.3d 1575 (Fed. Cir. 1996) 15

Johnson & Johnston Associates, Inc. v. R. E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002) 13

Malta v. Schulmerich Carillons, Inc., 952 F.2d 1320 (Fed. Cir. 1991) 7, 14

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) 13

Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995) 13

Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420 (Fed. Cir. 1997) 13

Texas Instruments, Inc. v. Cypress Semiconductor Corp., 90 F.3d 1558 (Fed. Cir. 1996) 7, 14

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997) 7, 8, 9, 12

Weisgram v. Marley Co., 528 U.S. 440 (2000) 12

STATUTES

35 U.S.C. § 112 13

RULES

Fed. Cir. R. 47.6 6

IN THE

Supreme Court of the United States

No. 02-1053

THE READ CORPORATION, F.T. READ & SONS, INC., AND NORDBERG-READ, INC.,

Petitioners,

v.

POWERSCREEN OF AMERICA, INC., POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD. AND POWERSCREEN INTERNATIONAL, PLC,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

BRIEF IN OPPOSITION

The petition seeks review of a non-precedential decision of the United States Court of Appeals for the Federal Circuit holding (1) that the evidence in this case was insufficient to support a jury verdict of infringement under the doctrine of equivalents, and (2) that respondents' pre-verdict motion for judgment as a matter of law adequately preserved their challenge to the sufficiency of the evidence of infringement. The first issue turns entirely on the application of routine legal principles to the unique factual record in this case. The second involves an evaluation of the wording of a particular pretrial motion. The decision is unpublished, presents no

legal issue of general applicability, and does not even arguably create a conflict among the circuits. The petition should be denied.

STATEMENT

1. Petitioner's United States Patent No. 4,237,000 (the '000 patent) describes and claims a component of a screening apparatus that separates excavation material into its fine (*e.g.*, loam and gravel) and course (*e.g.*, rocks and stumps) constituents. The screening device includes a "shaker assembly." The shaker assembly is generally rectangular in shape. It has a three-sided frame, consisting of two side plates that run from the front to the rear of the assembly and a back plate that traverses the rear of the structure and connects the side plates. Inside the frame are two levels of screens. The upper screen is of widely-spaced mesh. The lower screens are of a finer mesh. Each screen layer rests on a row of cross beams that run from one side of the shaker assembly to the other and are welded to the side plates. Thus, the device includes two tiers of cross beams—an upper tier on which the upper screen rests and a lower tier on which the lower screens rest. The entire shaker assembly slopes downward from the rear to the front of the earth screening device. A motor causes the shaker assembly to shake. *See* '000 Patent, Fig. 1, A200202-210 ("A" citations are to the appendix in the Federal Circuit proceedings).

A standard payloader dumps excavation materials into the screening apparatus from the rear. Course materials are unable to pass through the widely-spaced upper screen. They slide down the screen and fall to the ground at the front of the device. Less course materials pass through the upper screen onto the finer mesh lower screens. Rocks and debris that are too large to penetrate the lower screens slide down those screens and fall to the ground at the front of the apparatus.

Fine materials (loam and gravel) pass through the fine mesh lower screens and are captured inside the body of the device. They may then be removed and carried away. *See* A200008.

The '000 patent claims an alleged improvement to the prior art device described above. The improvement is the addition of a rigid longitudinal centerplate that runs down the middle of the shaker assembly from the rear to the front, parallel to the sideplates. Each of the upper and lower cross beams passes through, and is welded to, the centerplate. The centerplate is rigid. As a result, it holds all of the cross beams, upper and lower, in a fixed relationship to one another. When a load of construction debris is dumped on the shaker assembly, the centerplate distributes the resulting forces over all of the upper and lower cross beams so that each upper cross beam supports all of the lower cross beams, and each lower cross beam supports all upper cross beams. In addition, because the rigid longitudinal centerplate holds all of the cross beams in a fixed relationship, it causes the two screen decks to vibrate in unison when a load of earthen materials is dumped on the shaker assembly. This prevents out-of-phase vibration which, if it occurs, places intolerable stresses on the shaker assembly. A100862-63.

2. Claim 1 of the '000 patent, the only independent claim, states:

> In a shaker assembly for separating fine material from coarse material comprising longitudinal side plates, structural cross beams joining the side plates, a screen assembly spanning the space between the side plates and supported by the cross beams, and means for shaking the plates, cross beams and screen assembly, the improvement of:
>
> an upper screen assembly supported on an upper level of cross beams and a split lower screen assembly supported on a lower level of cross beams; and at least one *rigid longitudinal* center plate generally parallel to and between the side plates and *joining* the *upper and lower*

> *levels of structural cross beams such that forces applied to the screen assembly are transmitted through the center plate to the joined cross beams.*

See Pet. 5 (emphasis added).

The District Court construed this claim as requiring (1) a rigid longitudinal centerplate that (2) joins all of the upper and lower cross beams, (3) transmits forces applied to the shaker assembly to, and spreads those forces over, all of the upper and lower cross beams, and (4) prevents out-of-phase vibration of the screen decks. A100096-97, A101809-10. No objection was made to this claim construction at trial; and none was made on appeal. *See* A100927.

3. Respondents' accused device, called the Powergrid, includes a shaker assembly that, like the prior art, has side plates, a back plate, a wide-mesh upper screen supported by cross beams and fine-mesh lower screens, supported by a separate set of cross beams. A101592-101593. The Powergrid, however, did not have a rigid centerplate which joined the upper and lower levels of cross beams and held them in a fixed relationship so that forces were distributed over all cross beams and the screen decks would vibrate together.

Rather, the Powergrid had an upper centerplate, which provided support for its upper cross beams, and a distinct lower centerplate, which supported its lower cross beams. The upper and lower centerplates were each welded to the back plate (with a 3-inch attachment at the back plate). There was no other connection between the two centerplates anywhere along their seven foot-long length as they ran from back to front of the screenbox. As a result, the front end of one centerplate was free to, and did, move up and down independently of the front end of the other centerplate. Petitioners argued that the combination of these two

centerplates, forming a very elongated U-shaped structure when joined at the back, infringed the '000 patent under the doctrine of equivalents.

Petitioners' expert witness, Alexander Slocum, actually testified at trial to the *differences* between the claimed and accused structures. He explained that, unlike the single, rigid centerplate of the '000 patent, the Powergrid's structure allowed the fronts of the centerplates "to wobble up and down or deflect up and down" and permitted the "top structure" to vibrate at a "different frequency" from that of "the lower." A100897-898. The "large displacements" of the centerplates, the "motion occurring *between* the upper and lower decks," and the resultant "bowing" of the cross beams (*i.e.*, the bending of the cross beams at or near their mid-points) and out-of-phase vibration, caused cracking of the Powergrid's shaker assembly. A100897-898, A-100901, A100903-904, A100907.

The importance of the difference between the claimed rigid centerplate and the accused open-front structure (which allowed "motion occurring between the screen decks") was highlighted by petitioners' case against the version of the Powergrid that was introduced in 1997, shortly before the '000 patent expired. The 1997 structure included a series of bolt holes at the front ends of each centerplate. Petitioners argued that the bolt holes were intended to induce infringement because they invited users to install plates that would connect the otherwise separate front ends of the Powergrid's upper and lower centerplates. In support of that claim (which ultimately failed because there was no evidence that anyone in the United States ever installed the hypothetical front-connecting plates), petitioners' expert explained that it was a "very important structural goal in a machine like this to try and make the top and bottom [center]plate [structure] as rigid as possible so they shake as a rigid body without this breathing mode"—*i.e.*, without the

"up and down" movement of the front ends of the centerplates in opposite directions. A100898. Petitioners stressed that the attachment of front-connecting plates using the bolt holes would solve this serious problem. This testimony confirmed the substantiality of the difference between a structure having, and a structure lacking, a front connection that would unify the Powergrid's upper and lower centerplates and thus its cross beams and screen decks. A100901-905.

4. The jury found that the Powergrid's centerplates, without their front ends connected, did not literally infringe the '000 patent, but did infringe under the doctrine of equivalents. It also found respondents liable for inducing infringement. The district court denied respondents' pre-verdict and post-verdict motions for judgment as a matter of law, each of which asserted that there was insufficient evidence of infringement. In the post-verdict context, the district court specifically concluded that respondents' pre-verdict motion had adequately presented this issue. A101942.

5. The Court of Appeals reversed, in an unpublished opinion (which is therefore nonprecedential, Fed. Cir. R. 47.6). The court first agreed with the district court that respondents preserved their challenge to the sufficiency of the evidence of infringement under the doctrine of equivalents. Pet. App. A3. It observed that, although the "primary focus" of respondents' pre-verdict motion was on the inducement question (*i.e.* whether anyone had ever installed front-connecting plates using the bolt holes), the pre-verdict motion expressly and repeatedly asserted (in its introduction, headings, and conclusion) that there was not sufficient evidence of any infringement. Pet. App. A2-A3. The court noted that it is a patent-specific question—and hence a matter of Federal Circuit law—whether an assertion that there is no evidence of patent infringement suffices to preserve a claim that there is (more particularly) no evidence of infringement

under the doctrine of equivalents. Pet. App. A3 n.1. The court held that, under long-established Federal Circuit precedent, respondents' motion was sufficient. Pet. App. A3, citing *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1324-25 (Fed. Cir. 1991) (oral motion disputing the sufficiency of the evidence of infringement preserves appellate rights as to both literal infringement and infringement under the doctrine of equivalents); *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566 n.6 (Fed. Cir. 1996) (same).

On the merits, the court began with a recitation of the substantial evidence test in routine terms. It followed with a statement of the standards applied to a claim of infringement under the doctrine of equivalents drawn from this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 (1997). The opinion included a description of the "function and way and result" approach that petitioners themselves used in trying to establish equivalence. Pet. App. A3, A4. Petitioners do not challenge those statements of the law. The Court of Appeals then applied those standards to the record in this case, conducting a lengthy review of the trial testimony, to determine if indeed there was sufficient evidence that the accused device included the equivalent of each limitation in the claims. Pet. App. A4-A12. The Court concluded that there was not. Pet. App. A4-A5 ("After carefully reviewing the testimony . . . we conclude that Read failed to elicit the evidence necessary to support the jury's finding of infringement under the doctrine of equivalents").[1] Having decided the appeal on the narrowest available ground —an evaluation of the sufficiency of the particular evidence

---

[1] The court also held that petitioners failed to present sufficient evidence of inducement to infringe, because an essential element—actual installation of a front-end connecting plate, and thus the creation of an infringing structure by *someone*—was wholly unproved. Pet. App. 13. That ruling is not challenged in the petition.

offered at trial—the court had no occasion to determine whether the jury verdict of infringement by equivalents was also impermissible on the ground that it vitiated one or more claim limitations. Pet. App. A12.

Petitioners sought panel and *en banc* rehearing on the grounds now raised in this Court. Rehearing was denied.

ARGUMENT

Petitioners' challenge to the Court of Appeals decision is wrong on the merits, and, in any event, unworthy of review by this Court. The unpublished decision has no precedential value. It contains no significant legal rulings. No conflict of the circuits has been, or could be, suggested. The Court of Appeals applied undisputed legal standards. It performed a careful review, on an element-by-element basis, of the equivalents evidence—precisely what this Court has said should be done in cases of this type. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997) (stressing importance of summary judgment and JMOL review). Its decision is an utterly fact-specific application of settled legal standards regarding infringement by equivalents and the preservation of arguments for post-verdict review. The petition should therefore be denied.

A. Certiorari Should Not Be Granted With Respect To The Sufficiency Of The Evidence Question

1. The Court of Appeals correctly concluded that the evidence did not support a finding of equivalence. The claims of the '000 patent required, *inter alia*, a rigid longitudinal centerplate that joined the upper and lower cross beams. At trial, petitioners argued that the combination of the Powergrid's upper centerplate, which is connected to the Powergrid's backplate, and its lower centerplate, also connected to the back plate, "joined" the Powergrid's upper

and lower centerplates. They asserted that this elongated U-shaped structure was the equivalent of the claimed unitary centerplate. Under *Warner-Jenkinson*'s requirement of element-by-element equivalence, and the District Court's uncontested claim construction, this accused structure had to be the equivalent of a structure that (1) was "rigid," (2) prevented out-of-phase vibration of the two screen decks, and (3) distributed the forces initially imposed by a load of construction debris over all upper and lower crossbeams. Petitioners did not offer evidence that could have established any such equivalence.

The Court of Appeals explained carefully that petitioners' expert, Professor Slocum, stated nothing but bare conclusions as to function, way, and result. The petition does not appear to argue, and certainly does not demonstrate, otherwise. Pet. App. A6-A7. Far from satisfying petitioner's burden of proof, Professor Slocum's testimony affirmatively showed that the accused U-shaped construct, with no closure of the front ends, was seriously deficient, when compared to the claimed structure, precisely because it allowed Powergrid's upper and lower centerplates to move up and down in opposite directions, did not prevent out-of-phase vibration, and permitted bowing of the cross beams within each level, all of which repeatedly resulted in the failure of the Powergrid's shaker assembly. Professor Slocum's demonstrative aids even characterized the accused elongated U-shaped design, without front-end closure, as having "no effective center rib." A204044. This testimony was hardly accidental; it was the key underpinning of the petitioners' inducement case against the Powergrid's 1997 bolt hole design—which was premised on the prime importance of installing plates which would connect the front ends of the

Powergrid's separate upper and lower centerplates, and *thereby* create a rigid centerplate structure. As the Court of Appeals explained,

> Read introduced its inducement case through its expert, Mr. Slocum, who testified extensively as to the disadvantages of the Powergrid's centerplate structure. Specifically, he testified that Powergrid's dual centerplate structure allowed displacement between the screen decks, which resulted in cracking problems in the Powergrid shaker assembly. Accordingly, he advanced the theory that in 1997 Powerscreen introduced its "bolt hole" design to induce users to overcome the displacement between the Powergrid screen decks by bolting a connecting plate that joined the centerplates of each deck.

Pet. App. A5. There was not merely an absence of testimony establishing the *in*substantiality of the differences between the unitary, rigid, force-distributing, vibrative-synchronizing centerplate of the claims and the open-front structure of the accused device; there was testimony by the petitioners' expert that affirmatively demonstrated the substantiality of the differences.

In this Court, petitioners characterize certain witness testimony as meaning something the witnesses did not say. One excerpt (Pet. 7) is from respondents' employee, Neill Suitor. But, as the court below explained, this witness did not say that the Powergrid's centerplates transmitted forces from the upper to the lower cross beams (or vice versa); he said only that the upper and lower centerplates transmit forces among the cross beams *within each level*. Moreover, neither that excerpt, nor anything else, supplies (or could supply) the required evidence that the centerplates prevent out-of-phase vibration of the upper and lower screen decks. To the contrary, Mr. Suitor testified that Powergrid's separate

centerplate design allowed substantial out-of-phase vibration (a defect for which Powerscreen compensated by the use of other structural features). A101192-93.

A second excerpt from Mr. Suitor's testimony highlighted by petitioners (Pet. 7-8) is no more helpful to their case. As the Court of Appeals explained, the cited testimony says, and Mr. Suitor only reasonably could be understood to be saying, that the *screens* (not the *centerplates)* of the accused United States Powergrid design and the European Powergrid design (which, unlike the U.S. design, had front-end closure) performed the same function in the same way and achieved the same result. Pet. App. A10. Screens and centerplates are distinctly different structures, and Mr. Suitor had just finished testifying (two transcript pages earlier) that the front-closed (European) and front-open (United States) *centerplate* structures did *not* perform the same function. *See*, Pet. App. A10-A11.

Petitioners also point to an excerpt from the testimony of their expert, Professor Slocum. Pet. 9-10. That excerpt says that the Powergrid's upper centerplate joins its upper cross beams, that its lower centerplate joins its lower crossbeams, and that because the two centerplates are each welded to a back plate, there is an "inefficient" coupling of the screen decks. However, neither this statement, nor anything else in Professor Slocum's testimony, would allow a jury to conclude that the accused centerplate structure distributed forces initially imposed on one or a few cross beams over all cross beams, or performed the critical task of preventing out-of-phase vibration. To the contrary, as noted above, Professor Slocum characterized the Powergrid structure as non-rigid and as lacking any effective center-plate structure. *See supra* pp. 5-6, 9-10. As the Court of Appeals said, "the import of Mr. Slocum's testimony is that without a connecting plate [at the front end of its centerplates], the accused device was substantially inferior to the device recited in the patent. That

is not evidence of equivalence but of nonequivalence." Pet. App. A7-A8. The Court of Appeals thus correctly found no sufficient element-by-element evidence of equivalence.

2. In addition to being correct, the Court of Appeals' decision raises no issue of legal significance. Petitioners do not, and could not, suggest that the Court of Appeals misstated, or made new law respecting, the standards for infringement under the doctrine of equivalents. Rather, petitioners present a broad-brush attack on the Federal Circuit, arguing that its practice of reviewing the actual evidence in cases to ensure that it could reasonably be found to establish equivalence has eroded the Seventh Amendment's protection of the right to trial by jury. However, review of the sufficiency of the evidence, which goes on daily in federal appellate courts, has long been held to be perfectly consistent with the Seventh Amendment. *E.g.*, *Galloway v. United States*, 319 U.S. 372, 389 (1943); *See also Weisgram v. Marley Co.*, 528 U.S. 440, 450-452 (2000). And, whether the evidence actually is insufficient in a particular case necessarily depends on the facts of that case, a matter which is rarely of general legal significance, and certainly is not of broad significance in this case.

Petitioners supply no basis for the accusation that the Federal Circuit has lost its way in the course of performing precisely the sufficiency-of-the-evidence review that this court anticipated in *Warner-Jenkinson*, 520 U.S. at 39 n.8 (1997). Whether the evidence in the various cases petitioners cite was in fact insufficient would require a detailed, record-specific review of those cases, a task that petitioners do not even begin to undertake. Petitioners' argument amounts to nothing more than the meaningless observation that in a few other cases (a grand total of 7, according to petitioners, amidst the large number of Federal Circuit decisions in the last five years, Pet. 11, 17 n.10) the court has held that the plaintiff failed to offer sufficient evidence of equivalents.

Much of petitioners' remaining attack is simply beside the point. They point to various *legal* rulings in other Federal Circuit decisions on issues that are not presented in this case. For example, petitioners point to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), holding that claim construction is for the court (not the jury), but that issue is not presented here, and this Court has already reviewed and affirmed the Federal Circuit's position. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Petitioners cite *Johnson & Johnston Associates, Inc. v. R. E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002), where the Federal Circuit held that subject matter disclosed, but not claimed, in a patent is dedicated to the public (unless included in the claims of a continuation application). That issue has no bearing on this case. Petitioners rely on *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303 (Fed. Cir. 1998), which addresses the doctrine of equivalents in the context of a means plus function claim (*see* 35 U.S.C. § 112, para. sixth); but the claims here are not means plus function claims, and *Chiuminatta* therefore has no relevance. Similarly, the ruling on the '000 patent in this case involves no issue relating to the "pioneering" status of an invention, as in *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, 181 F.3d 1291 (Fed. Cir. 1999), and no issue of prosecution history estoppel, as in *Festo Corp. v. Shoketsu Kinzoko Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). Likewise, the Court of Appeals in this case had nothing to say about (respondents' argument relying on) decisions like Sage *Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), which state that the doctrine of equivalents may not be used to vitiate a clear structural limitation in a patent claim. There is, in short, no significant legal issue presented in this case.

B. Certiorari Should Not Be Granted With Respect To The Preservation Of Issues Question

No significant issue is presented by the Court of Appeals' holding—which is correct—that respondents' pre-verdict motion adequately preserved their post-verdict right to challenge the sufficiency of the evidence of infringement under the doctrine of equivalents. Respondents' pre-verdict motion for judgment as a matter of law directly asserted at least three times that the evidence at trial was not sufficient to support a verdict of infringement, and it sought a judgment of non-infringement. A000107, A000113, A000114, A000115. On that record, the District Court squarely held that respondents had indeed challenged the sufficiency of the evidence of literal infringement and of infringement by equivalents. It said:

> I think the challenge to the Court's rulings were timely and adequately made so that I would have, should have, been put on notice properly to follow the law. So we, we must deal with the law on the merits, it seems to me, not as a procedural matter.

A101942. The Court of Appeals drew the same conclusion.

Both rulings followed established precedent holding that a simple, conclusory statement that the evidence does not support a verdict of infringement is sufficient to preserve a defendant's right of appeal with respect both to literal infringement and to infringement under the doctrine equivalents. *Malta*, 952 F.2d at 1324-25; *Texas Instruments*, 90 F.3d at 1566, n.6. These decisions reflect the elementary fact that arguing for a judgment of no infringement necessarily encompasses both literal and equivalents infringement. The Court's ruling is not only sensible, it is a matter peculiarly within the procedural competence of the Federal Circuit. Moreover, this precedent defined what a defendant must do to preserve a non-equivalents argument for appeal. It would be

particularly unfair for respondents now, retroactively, to be held to a different standard.

Petitioners cannot support a different result by arguing that the pre-verdict motion, though adequately alerting the District Court to the issue, did not alert petitioners' counsel. First, regardless of counsel's subjective state of mind, the motion was sufficient under clear precedent (here, coupled with the district court's recognition of the motion's content). Second, petitioners did not argue in the trial court or in their brief in the Court of Appeals that they relied on respondents' supposed forfeiture of the right to contend that the evidence of equivalents was insufficient. If petitioners had truly been prejudiced, they surely would have, and in any event should have, made a concrete showing of prejudice long before simply making that assertion in their petition for rehearing in the Court of Appeals.

Petitioners also suggest that the decision below is somehow at odds with First Circuit precedent that they say requires that a ground for judgment as a matter of law be "distinctly articulated." Pet. 24, citing *Correa v. Hospital San Francisco*, 69 F.3d 1184, 1196 (1st Cir. 1995). Even if the Federal Circuit's decision in the present case were precedential, there would be no conflict of the circuits. The question here is whether a direct (thrice stated) challenge to the sufficiency of the evidence of "infringement" in a pre-verdict motion is a challenge that includes both sub-categories of infringement, or whether a litigant is required to incant the additional words "literally or under the doctrine of equivalents." The resolution of that question is an issue of patent law on which the First Circuit has not pronounced, and that has repeatedly and properly been decided by the Federal Circuit. Review of this issue should be denied.[2]

---

[2] Petitioners' argument that the decision in this case is at odds with the Federal Circuit's precedential decision in *Hoechst Celanese Corp. v. BP Chemicals Ltd.*, 78 F.3d 1575 (Fed. Cir. 1996), is similarly unavailing.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

ROBERT S. FRANK, JR.
ERIC J. MARANDETT
CHOATE, HALL & STEWART
53 State Street
Boston, MA 02109
(617) 248-5000

RICHARD G. TARANTO *
FARR & TARANTO
1220 19th Street, N.W.
Suite 800
Washington, D.C. 20036
(202) 775-0184

* Counsel of Record

Aside from the unpublished nature of the present decision, and the fact that such an intracircuit matter is not appropriate for this Court's review, the cases are materially different. In *Hoechst*, the defendants' pre-verdict motion argued only against a particular claim construction. The court was not presented with a general challenge to the sufficiency of the evidence of infringement of the type that was made in this case and that is addressed in the decision below.